

## REMARKS

The Examiner objected to the disclosure and drawings, citing various informalities. The Examiner rejected Claims 1-7 under 35 U.S.C. § 112, second paragraph as being indefinite. The Examiner rejected Claim 8 under 35 U.S.C. § 102(b) as being anticipated by Patent Number 5,477,017 ("Swindler"). Such rejections are noted.

Paragraphs 53, 54, 56, 57, 58, 59, 61, and 62 of the Specification have been amended. Claims 1, 3, 4, and 7 have been amended. Figures 20B, 22, and 23 have been amended. Applicant respectfully submits that Claims 1-8 are allowable.

### Objection to Informalities in Specification and Drawings

The Examiner objected to the disclosure and drawings, citing the following informalities:

- a. contrary to page 20, line 13, **2022** (Fig. 20B) does not indicate mounting holes,
- b. reference numeral **2022** appears to indicate three different items (Fig. 20b, Fig 23, and the specification),
- c. contrary to lines 30-32 of page 20, figs. 22 and 23 do not show holder **1904** or rounded slots in clip **2006**,
- d. contrary to page 21, lines 7-8, it does not appear that the internals can be viewed through window **2108**, since **2108** (fig. 21) indicates an internal *structure*,
- e. reference numeral **2204** is used to indicate contacts and blades (page 21, lines 18, 19, etc.),
- f. reference numeral **2206** is used to indicate contacts and holders (page 22, lines 10, 11, etc.), and
- g. the specification includes excessive discussion of features such as the cabinet, truck, etc. that are not the subject of the presently claimed invention.

Paper No. 4, para. 3 at 2.

With respect to item a. above, Applicants point out that the reference numeral **2022**, as used in paragraph 54 of the Specification, was used to collectively refer to numerals **2022A**, **2022B**, **2022C**, which appear on Figure 20B. Paragraph 54 has been revised to clearly reflect that the mounting holes are shown on Figure 20B as numerals **2022A**, **2022B**, **2022C**.

Confusion of reference numeral **2022** with that of the fuse holder assembly has been addressed with respect to item b., as described below.

With respect to item b. above, reference numeral **2022** in Figure 20B refers to the illustrated three-fuse holder assembly. Figure 20B has been revised to change this reference numeral to **2010'** to avoid confusion with the mounting holes **2022A**, **2022B**, **2022C**. Additionally, Paragraphs **53** and **57** have been revised to use the reference numeral **2010'**, instead of **2022**, when referring to the three-fuse holder assembly. Reference numeral **2022** does not appear in Figure 23. A revised drawing of Figure 20B has been included with this Response.

With respect to item c. above, Applicants have revised Paragraph **56** and Figures 22 and 23 to add reference numerals **2232A**, **2232B1**, **2232B2**, **2232C1**, **2232C2** to the slots in the upper fuse holders. Paragraph **56** has also been revised to reflect that the upper fuse holder **1904** has two illustrated embodiments, which are shown by reference numerals **2206A**, **2206B**, **2206C** on Figures 22 and 23. Applicants have revised Paragraph **53** to add the word "lower" when referring to the lower fuse holders **1908A**, **1908B**, **1908C**, which are illustrated in two embodiments: a lower two-fuse holder **2010** and a lower three-fuse holder assembly **2010'**. Applicants believe these changes eliminate the confusion regarding the upper and lower fuse holders, and the configuration of each. A revised drawing of Figures 22 and 23 have been included with this Response.

With respect to item d. above, Applicants agree that reference numeral **2108** points to a frame surrounding the view window into the disconnect switch **1902**. Applicants have revised Paragraph **58** to reflect that the reference numeral **2108** indicates the frame of the window for viewing the internals of the housing **2104**.

With respect to item e. above, Applicants have revised Paragraph **59** to change the reference numeral of the upper switch contacts from **2204** to **2202**. Additionally, Applicants have revised the reference numerals of Figure 23 to reflect that the view is of the third contact in the disconnect switch **1902** by adding "C" to the end of the reference numerals that are also shown on Figure 22. A revised drawing of Figure 23 has been included with this Response.

With respect to item f. above, Applicants have changed Paragraphs 59, 61, and 62 in the Specification to clearly delineate the various components identified on the drawings and to use consistent descriptions for the components. In particular, the Specification has been revised such that reference numeral 2206 refers to the upper fuse holder and reference numeral 2314 refers to the lower switch contact. This usage is consistent with the figures and the other portions of the Specification. Figure 22 has been revised to show reference numerals 2314A, 2314B, 2314C, and Figure 23 has been revised to show reference numeral 2314C. Revised drawings of Figures 22 and 23 have been included with this Response.

With respect to item g. above regarding the Examiner's assertion that the Specification contains excessive content, Applicants note that the thorough description of the motor controller and its components provides context and establishes the environment for the Applicants' invention. Also, there are five co-pending applications with similar disclosures that claim various inventions related to the medium voltage motor controller. Further, Applicants reserve the right to file continuations to claim any additional disclosed inventions during the pendency of this application. Finally, Applicants are not aware of, nor has the Examiner provided any reference to, any statute or rule restricting the length or content of the disclosure in an application. Accordingly, Applicants respectfully request the Examiner to withdraw his objection to the perceived excessive discussion.

Applicants respectfully submit that no new matter has been added to the Application by the above-identified amendments because the amendments correct reference numeral errors and ensure consistent use of component nomenclature in the Specification. Applicants respectfully submit that, with the above-identified changes to the drawings and Specification, the Examiner's objections have been completely addressed.

#### **Rejection Under 35 U.S.C. § 112, second paragraph**

The Examiner rejected Claims 1-7 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Claims 1 and 7, the Examiner states:

the second switch casting does not form the second switch contact. If the first contact is member **2304**, the second contact is **2204** (fig. 23). The lower structure comprises a pivot and other support members. However, since none of the other structures separate during operation, none can be considered to be switch contacts.

Contrary to claim 1 and 7, there is no casting forming both the second switch contact and the fuse holder. As seen from Fig. 23, the "contact" **2314** is one member and housing **2206** is a separate member. They are fastened together (see fasteners **2224** in Fig. 22). There is no teaching in the present application to make the contact and the fuse holder from a single casting.

Contrary to claims 1 (last section) and 7 lines 14-17), there is no electrical circuit formed when the switch is in an open position. When in an open position, the first switch contact and wiper are not in contact, thereby preventing a circuit therethrough.

Paper No. 4, para. 4 at 3.

Specification Paragraph 59, which has been amended as described above, describes the upper switch contacts **2202**, the switch blades **2204**, . . . , and the lower switch contacts **2314**. The Specification identifies two switch contacts, an upper **2202** and a lower **2314** for the disconnect switch **1902**.

Because Applicants can be their own lexicographers, the term "contact" as used in the claims must be interpreted as described in the Specification. *See* MPEP 2111.01, at 2100-48 (8th. ed.). Accordingly, the second switch contact corresponds to the lower switch contact, which is shown by reference numeral **2314**, not **2204**. Applicants have amended Paragraphs **59**, **61**, and **62**, as described above, to clarify the nomenclature and better identify the various components making up the present invention. However, Applicants have amended Claims 1 and 7 to change the term "wiper" to "blade" with respect to the third casting. This change was made to clearly reflect that the third casting corresponds to the blade that wipes against the first switch contact. Applicants respectfully submit that the "second contact" does not correspond to reference numeral **2204**, as maintained by the Examiner.

Applicants respectfully submit that the lower switch contact **2314**, the mounting pad **2222**, and the upper fuse holder **2206** is, in the illustrated embodiment, formed from a single casting. Reference numeral **2224** is described as openings for attaching the mounting pad **2222** to the disconnect switch housing **2104**. Paragraph **61** of the Specification states, "The mounting pad **2222** has openings **2224** used to attach the lower switch contact **2314** to the housing **2104**,"

which indicates that the openings **2224** are used to attach the mounting pad **2222** and lower switch contact **2314** to the disconnect switch housing **2104** and not to the upper fuse holder **2206**. Additionally, Claims 1 and 7, as they appeared in the initial filing of the application, teach that "a second casting form[s] a second switch contact and a first fuse holder." Applicants respectfully submit that the Application contains a teaching that the lower switch contact and the upper fuse holder are formed in a single casting.

Finally, Applicants agree with Examiner that there is no electrical circuit when a switch is open. Applicants have amended Claims 1 and 7 to correct the inadvertent use of the opposite switch position. The amendment to the claims replace "an open" with "a closed" in the portion of the claims describing the disconnect switch position. The amended claims are consistent with the description in Paragraphs **62** and **63** of the Specification.

Having no further rejection of or objection to Claims 1 and 7, it is respectfully submitted that Claims 1 and 7 are in condition for allowance. Accordingly, Claims 2-6 are also in condition for allowance as depending from an allowable base claim.

#### **Rejection Under 35 U.S.C. § 102(b)**

Addressing the Examiner's rejection of Claim 8 under 35 U.S.C. § 102(b), Applicant respectfully suggests that Swindler does not anticipate the claims of the present invention. Section 2131 of the Manual of Patent Examining Procedure describes the basis for anticipation under 35 U.S.C. § 102(b). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

With respect to Claim 8, the Examiner states:

This controller comprises a means for disconnecting 112, a means for illuminating the switch 122 and a means for racking 118, 120.

Paper No. 4, para. 6 at 3. In making this rejection, the Examiner cites Figure 1 of Swindler, which discloses a prior art draw-out type circuit breaker **112**. Swindler, Col. 3, lines 20-39. The breaker **112** includes a window **122** in front of the circuit breaker **112** for enabling a tool, such as an electric racking device **10**, to be coupled for engaging a conventional racking mechanism within the circuit breaker **112**. *Id.* at Col. 3, lines 24-30. Swindler does not disclose a disconnect switch such as a disconnect switch **204** disclosed by Applicants. Such a disconnect switch isolates the contactor **210** from the supply bus **202** and is separate from the draw-out disconnects **208** and **212**. Applicants' Specification, para. 18, Fig. 2.

Claim 8 includes means-plus-function limitations, as defined by 35 U.S.C. § 112, sixth paragraph. A means-plus-function limitation must be interpreted to cover the corresponding structure, materials, or acts in the specification and "equivalents thereof." 35 U.S.C. § 112, sixth paragraph; *see also* MPEP § 2181. The Examiner "must apply 35 U.S.C. 112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application." MPEP 2181, pg. 2100-209, 8th ed. (emphasis added).

In accordance with MPEP § 2181, it no longer is acceptable practice for the Examiner to interpret means-plus-function limitations "as reading on any prior art means or step which performed the function specified in the claim without regard for whether the prior art means or step was equivalent to the corresponding structure, material or acts described in the specification." MPEP § 2181, pg. 2100-209 (emphasis added). "[T]he application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim." MPEP § 2182, pg. 2100-214. "However, if a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function." *Id.* (emphasis added).

The MPEP states that the following factors are pertinent to "deciding whether an applicant has met the burden of proof with respect to showing nonequivalence of a prior art

element that performs the claimed function." MPEP § 2184, pg. 2100-218. "First, unless an element performs the identical function specified in the claim, it cannot be an equivalent for the purposes of 35 U.S.C. 112, sixth paragraph." *Id.* Other factors that support a conclusion that the prior art element is not an equivalent includes (A) the prior art element does not perform the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification, (B) a person of ordinary skill in the art would not recognize the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification, (C) there are more than insubstantial differences between the prior art element and the corresponding element disclosed in the specification, and (D) the prior art element is not a structural equivalent of the corresponding element disclosed in the specification. *Id.* "A finding according to any of the above [factors] would represent a sufficient, but not the only possible, basis to support a conclusion that an element is or is not an equivalent. There could be other indicia that also would support the conclusion." MPEP § 2184, pg. 2100-219.

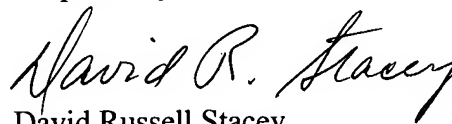
Accordingly, it is necessary to consider the specification in determining the scope of the rejected claim. Claim 8 includes limitations for "a means for disconnect switching; a means for illuminating a disconnect switch; and a means for racking in a contactor truck." Applicants' Specification in Paragraphs 53 to 63 and in Figures 19 to 23 disclose the structure for a disconnect switch. Swindler does not disclose a disconnect switch associated with the circuit breaker 112. Without a disconnect switch, Applicants respectfully submit that it is not possible for Swindler to disclose "a means for illuminating a disconnect switch." Accordingly, Applicants respectfully submit that Claim 8 is not anticipated by Swindler because Swindler does not disclose "an element [that] performs the identical function specified in the claim," namely, disconnect switching and illuminating a disconnect switch. Therefore, Swindler does not teach every element of the claimed invention. Accordingly, Applicants respectfully request that the Examiner withdraw his rejection of Claim 8.

## Conclusion

In view of the amendment of Claims 1, 3, 4, and 7, the amendment of Specification Paragraphs 53, 54, 56, 57, 58, 59, 61, and 62, and the amendment of Figures 20B, 22, and 23, it is believed that the above-identified patent application is in a condition for the issuance of a Notice of Allowance. Such action by the Examiner is respectfully requested. If, however, the Examiner is of the opinion that any of the drawings or other portions of the application are still not allowable, it will be appreciated if the Examiner will telephone the undersigned to expedite the prosecution of the application.

Please charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 19-3875(SPE-35).

Respectfully submitted,



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